

### **REMARKS**

Applicants have carefully reviewed the Final Office Action of June 4, 2007, in which claims 1-16 and 20-45 are pending in this application and have been rejected. Favorable consideration is respectfully requested.

#### ***Claim Rejections***

Claims 1, 36, 37, 39 and 40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Zhou, U.S. Pub. No. 2002/0183654. Applicants respectfully traverse the rejection because Zhou fails to disclose each and every claim element.

For example, claim 1 recites “a polymer jacket comprising a shape memory polymer attached to and surrounding a portion of the core wire such that a *substantial* portion of the polymer jacket is in contact with the core wire.” (Italics added.) Zhou does not disclose such a polymer jacket. For example, in Figure 4, second tip member 228 is shown as in contact with the core wire at the inner proximal end of the second tip member and at a portion of the distal inner edge. This one edge and part of another edge is not a substantial portion of the second tip member. When Applicants raised this point in the previous response, the Examiner responded by saying that “substantial is a broad term.” (June 4, 2007 Office Action, page 6.) While it may be true that “a substantial portion” is a term that does not have bright-line boundaries, the term is nevertheless not so broad or so vague that one can interpret it to mean anything at all. MPEP §2111 requires the Examiner to give claims “their broadest reasonable interpretation” and what is considered reasonable must be “consistent with the interpretation that those of skill in the art would reach.” For example, Zhou teaches that “adjacent turns 124 contact each other across substantially their entire length.” Paragraph 15. As one can see from Figure 1, most, if not all, turns 124 are in contact with adjacent turns along the length of the coil. This is a far greater percentage of contact than the extremely small percentage of contact shown in Figures 4 and 5 of Zhou. Applicants know of no uses in the art area where such a limited portion of one component being in contact with another is referred to as a substantial portion in contact with. If the Examiner persists in maintaining the rejection on this basis, Applicants request that the Examiner provide examples to show that the interpretation adopted by the Examiner is not impermissibly broad and is consistent with the interpretation that those of skill in the art would reach. Applicants respectfully submit that Zhou does not anticipate the claimed invention for at least the

reason that Zhou does not disclose a substantial portion of a polymer jacket in contact with a core wire.

Claim 1 also recites “the polymer jacket being more stiff than the portion of the core wire which it surrounds.” So far as Applicants can determine, Zhou fails to teach this. In the specification, Zhou is silent as to the relative stiffnesses of the core wire and the second tip member. Figures, such as Figures 4 and 5, illustrate the core wire bending while the second tip member is straight; one cannot, however, infer anything about the relative stiffnesses from such illustrations. As discussed in MPEP §2112, the fact that a certain result or characteristic may be present is not sufficient to establish the inherency of that result or characteristic. In Zhou, so far as Applicants can determine, nothing precludes the second tip member from being more flexible than the core wire which it surrounds. Applicants therefore submit that Zhou does not disclose this claim element.

Because Zhou does not disclose the claim elements as discussed above, Applicants respectfully submit that Zhou does not anticipate claim 1. As claim 36 recites “a substantial portion of the polymer jacket is in contact with the core wire, the polymer jacket being more stiff than the portion of the core wire which it surrounds” and claim 39 recites “a substantial portion of the polymer jacket is in contact with the outer surface of the core wire, the polymer jacket being more stiff than the portion of the core wire which it surrounds,” Applicants submit that these claims are allowable over Zhou for at least the reasons discussed above with respect to claim 1. As claims 37 and 40 depend from claims 36 and 39, respectively, and contain additional elements, Applicants submit that these claims are also in condition for allowance.

Further, claim 36 recites “a polymer jacket attached to and surrounding a portion of the core wire including the tapered portion *and the distal end* of the core wire.” (Italics added.) Zhou does not disclose (nor does the Examiner allege that Zhou discloses) a polymer jacket that surrounds the distal end of the core wire. For this additional reason, Applicants submit that claims 36 and 37 are allowable over Zhou.

Claims 5-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhou in view of Takahashi, U.S. Patent No. 6,485,458. Applicants respectfully traverse the rejection. For at least the reason that these claims depend from claim 1, which Applicants submit is allowable, and contain additional elements, Applicants submit that these claims are in condition for allowance as well.

Applicants further note that Zhou does not disclose any specific shape memory polymers for the second tip member. Where Zhou lists materials, in paragraph 22, it is in reference to materials for wire 122 and not for other components.

Claims 1-5, 20-24 and 36-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burmeister et al., U.S. Patent No. 5,452,726 (hereinafter "Burmeister") in view of Schroepel, U.S. Patent No. 6,024,764. Applicants respectfully traverse the rejection.

Burmeister teaches a guidewire with a selectively formable metallic core and a plastic jacket enclosing the core. Schroepel teaches a tubular sleeve for imparting a preselected shape in an implantable tubular device where the tubular sleeve may be made from a heat sensitive shape memory polymer. The Examiner argues that "it would have been obvious to one having ordinary skill in the art to modify the polymer jacket as disclosed by Burmeister et al. to include a shape memory polymer as taught by Schroepel so the device can be shaped by a surgeon into a shape and subsequently reshaped if desired to allow for introduction into the patient's anatomy.

However, a *prima facie* case of obviousness has not been made because all the claim elements are not taught or suggested by the cited prior art and there is no motivation to combine the references as suggested by the Examiner. For example, claim 1 recites "the polymer jacket being more stiff than the portion of the core wire which it surrounds." In Burmeister, the core wire is at least in part selectively formable to impart a shape to the wire, which suggests that the core wire is stiffer than the surround jacket. See column 5, lines 19-45. For this reason, in Burmeister as modified by Schroepel, we have no reason to suppose that the core wire becomes less stiff than the jacket; it is possible that the core wire remains stiffer than the jacket or that the core wire and the jacket are equally stiff.

Further, the motivation suggested by the Examiner that the modification allows the device to be shaped and reshaped by a surgeon does not apply. The guidewire of Burmeister, unmodified, "can be formed by a physician to a shape suitable for a particular patient or preferred by that physician." Column 5, lines 42-44. Further, unlike the sleeve of Schroepel, this shaping of the guidewire of Burmeister can be done at ambient temperature and does not require heating above a glass transition temperature. Therefore, the guidewire of Burmeister already has the features that form the basis of the Examiner's proposed motivation and has them in a more convenient form. Applicants thus submit that there is no motivation to combine the references.

Applicants therefore submit that claim 1 is in condition for allowance. As claims 2-5 depend from claim 1 and contain additional elements, Applicants submit that these claims are in condition for allowance as well.

Claims 20, 36, 39 and 45 each recite "the polymer jacket being more stiff than the distal tip portion of the core wire which it surrounds." Therefore, for the reasons discussed above with respect to claim 1, Applicants submit that these claims are also in condition for allowance. As claims 21-24, 37-38 and 40-44 depend from one of claims 20, 36 and 39 and contain additional elements, Applicants submit that these claims are in condition for allowance as well.

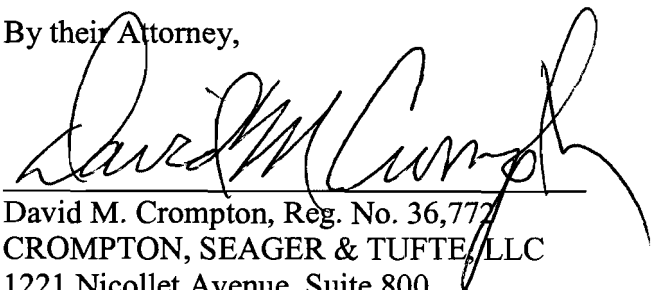
Claims 6-16 and 25-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burmeister in view of Schroepel and further in view of Takahashi. Applicants respectfully traverse the rejection. As discussed above, Burmeister in view of Schroepel does not teach or suggest all the elements of claims 1 or 20, from which these claims depend, nor is there a suggestion or motivation to combine these references. Takahashi does not remedy the deficiencies of Burmeister and Schroepel. Therefore, because claims 6-16 and 25-35 depend from one of claims 1 or 20, which Applicants submit are allowable, and contain additional elements, Applicants submit that claims 6-16 and 25-35 are in condition for allowance as well.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

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By their Attorney,



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